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09/584,375	05/31/2000	Bruce Henry Garvie	GAR-001	1354
21884	7590	07/28/2004	EXAMINER	
WELSH & FLAXMAN LLC 2450 CRYSTAL DRIVE SUITE 112 ARLINGTON, VA 22202			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 1

Application Number: 09/584,375
Filing Date: May 31, 2000
Appellant(s): Bruce Henry Garvie

John L. Welsh
For Appellant

EXAMINER'S ANSWER

MAILED
JUL 28 2004
GROUP 3700

This is in response to the appeal brief filed May 10, 2004

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-5 and 12-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together **and** reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

EP 342,232	Aotani	11-1989
US 2,222,650	BRADY	11-1940

US 5,996,260

MacNeill

12-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference to Aotani EP 342,232 (EP '232) in view of Brady 2,222,650 and MacNeill 5,996,260. EP '232 discloses all the limitations substantially as claimed including the following: an insert (41a, 51a, 61a); a traction member (41b, 51b, 61b); the insert and traction member are distinct elements (see Figures 4b, 5b, 6b); the insert formed of a synthetic plastic material (see col. 5, lines 15-46 and col. 3, line 58-col. 4, line 15); the insert having a stem portion with releasable engagement means (see Figures 4b, 5b, 6b stem is threaded); the traction member secured to the insert and encasing the insert (see Figures 4b, 5b, 6b); the insert made entirely of synthetic plastic material (see col. 5, lines 15-46 and col. 3, line 58-col. 4, line 15); the stem portion having a first end (with threads) and a second end (with flange); the first end of the stem portion having engagement means (threads); the second end having a securing formation (flange); the insert having a spike opposite the first end 61e; traction member

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has a pair of passages arranged to receive a fastening tool (41d, 61d); the flange is extending radially from the stem (see Figures); the flange has a plurality of apertures through it (those for fastening the cleat to the shoe). EP '232 does not teach or disclose the traction member being made of plastic, the insert having a raised spike opposite the first end of the stem portion and aligned with the traction member and the plastic members having different hardnesses or colors. Brady '650 teaches that an insert with a traction member attached can have a raised spike 31 located on the insert and aligned with the traction member (point of 32) to aid in penetrating the ground. Brady '650 also teaches that the insert can be encased, except for the threaded portion, by rubber (as shown in Figure 15) to aid in the penetration of the ground by the traction member. MacNeill '260 teaches that outer traction member portion encasing an insert can be made of natural rubber, thermoplastic rubber, soft polyvinyl chloride, soft polyurethane, or soft plastic thereby aiding in gaining traction. This teaches that plastic can be used in place of rubber as the outer traction member of a spike to aid in gaining traction with the ground. MacNeill '260 also teaches that the different plastics used in a spike insert and traction member can be made of different colors (col. 3, line 58-col. 4, line 11) to aid in determining the wear and tear on the cleat. Furthermore, MacNeill '260 teaches that the material of the traction member and the base can be made of different hardnesses, the material of the traction member being softer (i.e. less hard) than the material of the base (see col. 3, lines 11-42), the softer outer layer aiding in improving traction and the stiffness and hardness of the base layer aiding in giving support to the projections. Therefore, it would have been obvious, in view of Brady '650, to make the

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insert of a traction member with a spike that is aligned with the traction member, as shown in Brady '650, as well as encase the entire insert, except for the threaded portion, in rubber to aid in penetrating the ground and gaining traction. Furthermore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the traction member and insert member of EP '232 out of plastics, as taught by MacNeill '260, which can be of different hardnesses and colors, as taught by MacNeill '260, to aid giving support to the projection and help in dispersing impacts and to aid in visually determining the wear and tear on the cleat. With respect to claim 3 and the hardness of the materials, it appears that it would have been a mere matter of testing and optimization to find the hardness of the material of the insert that would allow for proper mounting of the cleat and preventing shearing of the stem.

Response to Amendment

3. Applicant's request for reconsideration has been thoroughly considered but has not been found persuasive. Applicant argues "Applicant's opinion that any modification of the rubber in Aotani or Brady based upon the disclosure of MacNeill would be inappropriate." This argument is not clearly understood. Applicant argues that Aotani does not disclose a plastic traction member as claimed. This argument is addressed in the combination of references as applied above. Furthermore, applicant argues that there is no teaching of substituting plastic for rubber in any of the references. This argument is addressed with respect to the disclosure of McNeill, which teaches the ability of using plastic in place of rubber, as noted in the rejection above. Applicant also

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states that there is the teaching of encasing one plastic in another plastic limitation has not been addressed. This teaching is shown in the combination of references as noted in the rejection set forth above. Applicant further argues that there is no suggestion of motivation to modify or combine the reference teachings. This argument is not clearly understood. The reasons to combine are clearly set forth in the rejection above due to the teachings of the references. Applicant argues that modifying Aotani and Brady would be contrary to the teachings of each reference. This argument is not clearly understood. The modifications noted in the rejection above would not destroy the references as McNeill teaches that rubber and plastic can be used for the same purpose. Applicant's arguments with respect to claim 4 are not clearly understood. It appears applicant is arguing more than that which is claimed. The claim only requires that the "raised spike" act as a wear indicator and does not mention any color change to indicate wear. Since the "raised spike" will wear with use, the shortening of the spike will act as the wear indicator, thereby meeting the limitations of claim 4.

(11) *Response to Argument*

For purposes of clarity, the response to appellant's arguments will be listed under the same heading as that used by the appellant in the appeal brief.

Response to Appellant's Arguments

I. Response to Appellant's arguments that Claims 1-3 and 12 -20 are not obvious under 35 U.S.C. § 103(a) Based upon the disclosures of Aotani in view of Brady and MacNeill:

Appellant argues that 'it is the appellant's opinion that any modification of the rubber of Aotani or Brady based upon the disclosure of MacNeill would be inappropriate. Appellant argues that Aotani "does not disclose a plastic insert encased **during a molding process** with a plastic traction member." (emphasis added). Since appellant is claiming a product and not the method or process of making the product, finding how or when the plastic insert is encased with a plastic traction member is not necessary to meet the structural limitations of the claimed invention. Appellant further argues that Aotani does not cover any of the spikes with plastic or rubber. This argument is unclear as the other references in the rejection were used to teach this limitation in the claims. Appellant further argues that since Aotani chose not to cover the entire cleat with a rubber traction member as he chose to do in the embodiments of Figures 4 and 5, then covering it as suggested by Brady would be contrary to Aotani's invention. This argument is also not clearly understood. Appellant admits that Aotani had suggested covering the entire cleat with rubber but did not cover the cleat with a spike with rubber. There is no suggestion in Aotani for why the spike on the cleat was not covered or that it was not desired to cover the spike. Furthermore, the suggestion to cover the spike on the end of a cleat with rubber was suggested by Brady as noted in the rejection and shown in Figure 15 of Brady. Therefore, Brady teaches the covering of the spike at the end of a cleat with rubber, as admitted by the appellant on page 7,

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last paragraph of the Appeal Brief. Appellant argues that the rubber of Brady stretches in order to enable the peg to penetrate the ground and that the rubber is not secured via a molding process. This argument is also not clearly understood. Firstly, although the peg of Brady is said to be "completely enclosed in a sheath of rubber. The rubber may deform and stretch to enable the peg to penetrate the ground.", appellant has not claimed that the cover for his plastic traction member cannot stretch or does not stretch. Therefore, since the rubber of Brady performs the function of covering the peg as claimed by the applicant, the combination of Brady with Aotani with the teachings of MacNeill present a prima facie case of obviousness. Appellant argues that the covering of Aotani with the rubber of Brady would run contrary to a quality design. This argument is also not clearly understood. It is not clear how an argument directed to the quality of design overcomes the teaching of Brady to place a rubber cover completely over the peg and spike. Applicant further argues the differences between plastic as claimed and rubber as used in Aotani and Brady. This argument is not clear as there is clearly a teaching in MacNeill to substitute plastic for rubber in spike construction as noted in the Final rejection. Appellant's argument that traditional use of rubber in footwear as friction creating material, which "sticks" to a surface and plastic is relatively hard and durable material is not clearly understood. In column 3, lines 39-42, MacNeill teaches that the soft outer layer 20 (previously defined in the reference as a soft deformable plastic) improves traction or slip resistance in environments other than turf penetrating athletic surfaces such as on smooth or slick surfaces, e.g., tile floors. Therefore, this teaches that plastic can also be used for the same purpose, i.e. friction creating material which

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"sticks" to a surface upon which it contacts, in the same fashion as the rubber disclosed in Brady and Aotani. Furthermore, MacNeill teaches that the third material (the soft outer layer) may be chosen to be relatively soft so as to resiliently absorb some of the impact forces of the cleat engaging the ground (see col. 1, lines 42-44). Therefore, substituting the plastic of MacNeill with the rubber of Brady would not destroy the Brady reference as it would be able to perform in the same fashion. Appellant also argues that the Office Actions fail to show or teach any reference wherein one plastic is encased in a second plastic during a molding process. Since the process of how the plastics are encased is not being claimed and only the structural product is being claimed, how or when the plastics are encased is given no patentable weight. Appellant further argues that the appellant does not want his materials to stretch. It appears that the appellant is arguing more than that which is claimed, as there is no suggestion in the claims of the lack of stretching. Therefore, since it has been shown that MacNeill teaches the use of soft plastic for traction, the same purpose of the rubber of Brady, the combination set forth in the Final Office action sets forth a prima facie case of obviousness with a reasonable expectation of success in modifying Aotani based upon the teachings of Brady and MacNeill without the final product destroying the intended final product. With respect to claims 12 and 15, the arguments applied above apply as well to these claims. As to claims 2-3, 13-14 and 16-20, since the rejections of claims 1, 12 and 15 are shown to be proper, the rejections to these claims would also stand.

II. Response to Appellant's Arguments that Claim 4 is not obvious under 35 U.S.C. § 103 (a) based upon the disclosure of Aotani in view of Brady and MacNeill.

Appellant has failed to give reasons why claims 4 and 5 fall separately from the other claims on appeal (see part (7) above). Therefore, claim 4 would fall with the other claims for the reasons indicated above. But, for clarity and to respond to appellant's argument, the following arguments would apply.

Appellant argues that the "raised spike" disclosed by Aotani may not function as visual wear indicator as it is not encased within the traction member. This argument is not clear. Appellant is attacking the references individually rather than together as a whole. The teaching of encasing the "raised spike" is taught by Brady and the indicating function of the spike is taught by MacNeill, as noted in the final rejection in the Final Office Action enclosed above.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



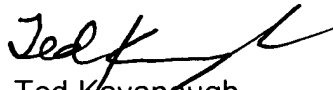
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